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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,897	09/30/2003	Eiju Maehara	16589-002001	4842
26211	7590	09/28/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			DIMYAN, MAGID Y	
			ART UNIT	PAPER NUMBER
			2825	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,897

Applicant(s)

MAEHARA ET AL.

Examiner

Magid Y. Dimyan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/30/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This pertains to U.S. Patent Application No. 10/674,897, filed 30 September 2003. Claims 1 – 7 remain pending in this application.

Specification

2. The abstract of the disclosure is objected to because the acronyms SIP and ISP need to be defined before usage. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: the title of the disclosure is not descriptive, since there are many other methods of manufacturing circuit devices. The title needs to provide some indication as to the method drawn by the claims.

Appropriate correction is required.

Claim Objections

4. Claims 2, 3, 4, 6 and 7 are objected to because of the following informalities: in claims 2, 3, 4, 6 and 7: on line 1, delete "A method" and insert --The method--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Publication No. US 2001/0044667 A1 to Nakano et al. (hereinafter, "Nakano") in view of patent No. US 6,256,769 B1 to Tamarkin et al. (hereinafter, "Tamarkin").

7. Regarding claims 1 and 5, Nakano teaches a method of manufacturing a circuit device (see Abstract; paragraph 0005) using a terminal and a server which are connected to each other via a communication network (see Figs. 1 – 4), the method comprising: (a) a condition inputting step for inputting conditions to be satisfied by the circuit device through the terminal and transmitting the conditions from the terminal to the server (see Figs. 1 – 4; paragraphs 0047 – 0050); (b) a manufacturing data generating step for receiving the input conditions and generating at the server side manufacturing data for manufacturing the circuit device based on the condition (see (Figs. 9 and 10; paragraphs 71 – 73); and (c) a manufacturing step for manufacturing the circuit device based on the generated manufacturing data (see again Figs. 1 – 6 and 9 - 10; paragraphs 71 – 73). Thus, Nakano teaches all the claimed elements, except for the limitation of circuit device having an IC and a passive part covered with and supported by an insulating resin. On the other hand, Tamarkin cites a technique for defining and routing printed circuit boards that can be implemented over the Internet

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(see col. 2, lines 29 – 39) that also cites using an insulating (plastic) resin in his disclosure (see col. 4, lines 18 – 29). Since resins are commonly used in PCBs, and PCBs are very well known and used in the art of ICs, it would therefore be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nakano and Tamarkin to obtain the same claimed invention.

8. As per claims 2 and 7, see (4) above, as well as Figs. 11 and 12; paragraph 0119, which teach the claimed element of the evaluation step for evaluating at the server side the reliability of the circuit to be manufactured based on the conditions.

9. Pursuant to claims 3 and 6, Nakano and Tamarkin collectively teach the claimed limitations pertaining to IC specifications, manufacturing data, mask and placement data (see Nakano – paragraphs 0003, 0058, 0062, 0063), coordinate data for placing devices on a board i.e., wire bonding coordinates (see Tamarkin – Fig. 3, block 102; col. 5, lines 58 – 65).

10. As for claim 4, see Nakano – Fig. 8; paragraph 0119, which show the web browser used to input the conditions, as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magid Y. Dimyan whose telephone number is (571) 272-1889. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Magid Y Dimyan
Examiner
Art Unit 2825

myd
20 September 2005

MYD

A. M. Thompson
Primary Examiner
Technology Center 2800

